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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,895	09/27/2005	Katsuyoshi Fujiwara	1560-0439PUS1	3722
2292 7590 01/08/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER LEUNG, JACK C				
ART UNIT 4142		PAPER NUMBER		
NOTIFICATION DATE 01/08/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/550,895

Applicant(s)

FUJIWARA ET AL.

Examiner

JACK LEUNG

Art Unit

4142

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8, 10-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 10-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The applicant amended claims 7 and 13 and canceled claims 9 and 15 in the amendment received 11/18/08.

The claims 7, 8, 10-14, and 16-18 are pending.

Response to Arguments

2. Applicant's arguments filed in the amendment received on 11/18/08 have been fully considered but they are not persuasive.

A. The applicants argue that Malik does not teach wherein said controller is further capable of accepting only an address containing the partial address registered in the storing unit from input.

However, the examiner respectfully traverses. Claim 9 recites "...accepting only an address containing the partial address registered in the storing unit from input." That is, upon accepting only an address containing the partial address that is registered in the storing unit from input, the data is processed and transmitted. Malik discloses:

If the domain name database does not detect the extracted domain name in step 53, **the system provides a prompt to the user** in step 56. The prompt can occur in several possible formats. For example, the e-mail server may send a network message alert to the sender's personal computer, or may generate and transmit an e-mail message containing the prompt. (section 38).

Upon accepting an address containing a partial address that is **not registered** in the storing unit from input, transmission does not occur. Instead, **a network message alert or prompt is sent to or displayed to the user, which requires further user intervention.** (section 38). Claim 15 is likewise traversed.

Therefore, the applicants' arguments are not persuasive.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 10, 11, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifert (U.S. Publication No. 2004/0068543 A1) in view of Malik (U.S. Publication No. 2002/0065891 A1.)

With respect to claim 7, Seifert teaches a controller capable of registering a partial address (i.e., Group data strings are used to define which incoming e-mails are to be accepted and/or which out-going e-mails are to be transmitted by the e-mail server and/or e-mail client operating on the e-mail user's behalf, wherein group data strings are from at least one of the "From:", "To:", "Subject:" and "Message:" fields of the e-mail under consideration. For example, data strings of one group identify one or more remote e-mail users and/or remote domain names from which e-mail is always to be accepted, sections 11 and 13.) that is in common with a plurality of addresses in a storing unit, among unique addresses that are receiving ends of data (i.e., An e-mail processor comprising means for storing one or more data groups, each group

consisting of from none to a plurality of group data strings, section 11); and restricting data transmission to the addresses that contain the partial address registered in said storing unit (i.e., The processor can provide the administrator in an organizational operating environment with additional controls to determine which incoming e-mails should reach the intended recipient, and which e-mail messages from within the organization are acceptable for transmission, section 12.). Seifert teaches an input unit for inputting an address of a receiving end (i.e., means of a keyboard, mouse, voice recognition software, etc. in order to generate commands necessary to interact with the communication system, section 31), but it does not disclose wherein said controller is further capable of accepting only an address containing the partial address registered in the storing unit from input. However, Malik teaches wherein said controller is further capable of accepting only an address containing the partial address registered in the storing unit from input (i.e., automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising the steps of storing a list of e-mail addresses in a memory, checking if an e-mail address in the e-mail communication is included in the list of e-mail addresses in the memory, and generating a prompt for a user to confirm an e-mail address if the domain name is not included in the list of e-mail addresses, section 20) in order to reduce the occurrence of incorrectly addressed e-mail communications. Therefore, based on Seifert in view of Malik, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Malik to the system of Seifert in order to reduce the occurrence of incorrectly addressed e-mail communications.

With respect to claim 8, Seifert further teaches said controller further capable of interrupting data transmission, when a received address contains no partial address registered in said storing unit (i.e., the processor can include means for permitting the transmission of e-mail meeting the authorization criteria defined by the group data strings for authorizing the transmission of e-mail, and for rejecting the e-mail if none of those criteria are met, section 14).

The limitations of claim 10 are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

With respect to claim 11, Seifert teaches said addresses are e-mail addresses, and said partial address is a domain except for a user name. (i.e., an "e-mail address" is typically the username separated from the domain name by the symbol, "@", section 7.)

The limitations of claim 13 are rejected in the analysis of claim 7 above, and the claim is rejected on that basis.

The limitations of claim 14 are rejected in the analysis of claim 8 above, and the claim is rejected on that basis.

The limitations of claim 16 are rejected in the analysis of claim 10 above, and the claim is rejected on that basis.

The limitations of claim 17 are rejected in the analysis of claim 11 above, and the claim is rejected on that basis.

5. Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seifert (U.S. Publication No. 2004/0068543 A1) in view of Malik (U.S. Publication No. 2002/0065891 A1.), and further in view of Nishida (U.S. Patent No. 6,972,858 B1.)

With respect to claim 12, Seifert and Malik teach the claimed subject matter as discussed above except that the data transmitting apparatus is an Internet facsimile apparatus that transmits image data. However, Nishida teaches an Internet facsimile apparatus that transmits image data (i.e., transmits image data as an E-mail over the Internet, abstract) in order to automatically recognize whether or not a receiver side has IFAX functions. Therefore, based on Seifert in view of Malik, and further in view of Nishida, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Nishida to the system of Seifert and Malik in order to automatically recognize whether or not a receiver side has IFAX functions.

The limitations of claim 18 are rejected in the analysis of claim 12 above, and the claim is rejected on that basis.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACK LEUNG whose telephone number is (571)270-7215. The examiner can normally be reached on Monday thru Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (James) Joon Hwang can be reached on 571-272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JACK LEUNG/
Examiner, Art Unit 4142
12/18/08

/Joon H. Hwang/
Supervisory Patent Examiner, Art Unit 4142